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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,131	04/19/2000	Anuradha Narasimhaswamy Melkote	81056803	3473
28395 7590 01/10/2008 BROOKS KUSHMAN P.C./FGTL 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075-1238			EXAMINER LY, ANH	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/552,131	MELKOTE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anh Ly	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/05/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is response to Applicants' AMENDMENT filed on 11/28/2007.
2. Claims 1-41 are pending in this Application.

### ***Response to Arguments***

3. Applicant's arguments filed 11/28/2007 have been fully considered but they are not persuasive.

Applicant argued that, "filing date of TRAN appears to be MAY 1, 2000, after the filing date of the instant application." (page 8, in the remarks).

Examiner respectfully disagrees as argued. In response to Applicants' arguments, In the front page of TRAN's publication No.: US 2002/0095368 A1 printed that this is a provisional application No. 60/185,644, filed on Feb. 29, 2000, which is before the filing data of the instant application.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

4. Applicant's arguments, see pages 9-15, filed 11/28,2007, with respect to the rejection(s) of claim(s) 1, 17, 23 and 37 under "forming an invention disclosure online by entering a plurality of selected information into a web-based system" have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

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However, upon further consideration, a new ground(s) of rejection is made in view of

Pub. No.: US 2001/0049707 A1 to TRAN et al.

5. Examiner acknowledges the amendments dated 11/28/2007, which was overcome the rejection 35 U.S.C. §112.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16, 17-20, 22, 23-36 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0095368 A1 of TRAN (Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Pub. No.: US 2006/0010377 A1 of Anecki et al. (hereinafter Anecki) (provisional application No.: 60/187,444, filed on Mar. 7, 2000) and further in view of Pub. No.: US 2001/0049707 A1 of TRAN (hereinafter TRAN707) (Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) .

With respect to claim 1, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, sections 0016-0017 and 0020-0022), comprises the step of:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the use enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: sections 0014-0015 and abstract).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information and allowing online access to the status of invention disclosure, said status comprising said invention disclosure is in a reviewing and application filing process.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of

legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 2, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in

response to the identification information (identification information to the user and searching information: sections 0026 and 0029).

With respect to claims 3 and 8, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach comprising the step of prompting the user for classification information.

However, Anecki teaches filtering information via a "Filter" button as shown on fig. 21 (sections 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 4-7, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).



TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach notifying an evaluator in response to the classification information prompting an evaluation from the evaluator, notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in the e-mail; scheduling an evaluation meeting and ranking the disclosure.

However, Anecki teaches evaluating the information and approving the legal document (section 0092); generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (sections 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 8-9, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

With respect to claims 10-12, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein.

However, Anecki teaches web server as shown in figs. 8 and 10 (sections 0095 and 0101-0102) and generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing

the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 13-14, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein.

However, Anecki teaches email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing

the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 15 and 16, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and password and submitting the form storing in the patent database: sections 0005, 0007, 0017, 0024 and 0026).

With respect to claim 17, TRAN teaches an invention disclosed system (fig. 1), comprising:

- at least one user computer accessible by a plurality of inventors associated with a single invention disclosure (fig. 1);

- a server coupled to said at least one user computer (fig. 1);

- a database coupled to the server (fig. 1);

- and said server providing user screen to said least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, after storing the plurality of disclosure information within said database (fig. 1, user interface is web-based user interface and system prompts for user to enter information to the system: sections 0014, 0016-0018).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach prompting said plurality of inventors for invention disclosure approval.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach receiving the plurality of disclosure information from said users, storing information in said database after each of the plurality of disclosure information is entered, allowing access to said disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 18, TRAN teaches comprising a directory system coupled to said server whereby upon proving identification information to sever said server retrieves user information from the directory system in response to the identification information (identification information to the user and searching information and user has to sign-in/sign-off the system: sections 0016-0018 and 0026 and 0029).

With respect to claim 19, TRAN teaches wherein said server comprises a web server (a web server: fig. 8 and 10, sections 0095 and 0101-0102).

With respect to claim 20, TRAN teaches wherein said user computer comprises a web browser for accessing said server (using a browser for viewing: sections 0008 and 0027).

With respect to claim 22, TRAN teaches wherein server comprises a web single login to access said invention disclosure (sign-on and password: sections 0016 and 0023-0024).

With respect to claim 23, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, sections 0016-0017 and 0020-0022) comprising:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the use enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: sections 0014-0015 and abstract) and

prompting the user for classification information, which refers to a technology area (technical of the invention and categorization: sections 0019 and 0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach allowing access to various users to access the information; notifying an evaluator in response to the classification information and prompting an evaluation from evaluator.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059) and evaluating the information and approving the legal document (section 0092).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the

purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 24, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (identification information to the user and searching information: sections 0026 and 0029).

With respect to claims 25-27, TRAN teaches a method as discussed in claim 23.



TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in the e-mail; scheduling an evaluation meeting and ranking the disclosure.

However, Anecki teaches generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (sections 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 28-29, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

With respect to claims 30-32, TRAN teaches a method as discussed in claim 23.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein.

However, Anecki teaches web server as shown in figs. 8 and 10 (sections 0095 and 0101-0102) and generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 33-34, TRAN teaches a method as discussed in claim 23. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein.

However, Anecki teaches email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 35 and 36, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and password and submitting the form storing in the patent database: sections 0005, 0007, 0017, 0024 and 0026).

With respect to claim 37, TRAN teaches a method of submitting documents (submitting IP document: sections 0017), comprising:

entering identification information into a user computer (sign-on with user name/user ID and password: sections 0016 and 0024-0026); and

coupling said user information with said invention disclosure (user information: sections 0016, 0023-0024 and 0034).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach retrieving user information from a directory system in response to said identification information, storing the disclosure in a computer database, performing a search is at least the state of art associated with said invention disclosure and wherein said search is at least partially directed by at least one inventor of said invention disclosure.

However, Anecki teaches searching/retrieving legal documents (sections 0040 and 0060), storing legal document in the legal document database (section 0050) and performing search the legal documents or prior arts (see fig. 1 and section 0041).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach entering disclosure information to create an invention disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets,

thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claims 38-39, TRAN teaches a method as discussed in claim 37.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not clearly teach prompting the user for classification information, notifying an evaluator in response to the classification information prompting an evaluation from the evaluator.

However, Anecki teaches filtering information via a "Filter" button as shown on fig. 21 (sections 0122-0123 and 0128) and evaluating the information and approving the legal document (section 0092).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 40-41, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0095368 A1 of TRAN (provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Pub. No.: US 2006/0010377 A1 of Anecki et al. (hereinafter Anecki) (provisional application No.: 60/187,444, filed on Mar. 7, 2000), and further in view of Pub. No.: US 2006/0190443 A1 of Mathews et al. (hereinafter Mathews) (continuation of application No.: 09/539,500, filed on Mar. 30, 2000).

With respect to claim 21, TRAN view of Anecki discloses an invention disclosure system as discussed in claim 17.

TRAN and Anecki disclose substantially the invention as claimed.

TRAN and Anecki do not teach comprises a computer aided design (CAD) file view coupled to said web browser.

However, Mathews teaches using CAD and CAD facility for viewer (section 0054; also see sections 0051-0054).


Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify TRAN and Anecki's system to include CAD facility for viewer as taught by Mathews in order for providing a way to view the legal document or IP. The motivation being for providing access to drawing information and distribution of design drawing data, thereby, viewing the information or files over the Internet using a browser (Mathews's section 0007 and 0020).

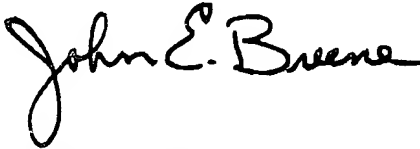


**Contact Information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV (written authorization being given by Applicant(s) - MPEP 502.03 [R-2]) or fax to (571) 273-4039 (unofficial fax number direct to examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

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JAN. 6<sup>th</sup>, 2008

  
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